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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,224	10/24/2005	Kuniaki Ishibashi	052638	7956
38834 7590 01/22/2010 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
HUDA, SAIED M				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
01/22/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

# Office Action Summary

## Application No.

10/554,224

## Applicant(s)

ISHIBASHI ET AL.

## Examiner

SAEED M. HUDA

## Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The response filed on 10/01/2009 has been fully considered and entered into the record. Claims 2 and 9-15 are cancelled and the rejections applying to the cancelled claims withdrawn.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1 and 3-8 have been considered but are moot in view of the new grounds of rejection.

Applicant states that the present invention is no rendered obvious over the disclosures of Sakamaki in view of APA. The Examiner has provided for a new rejection thus the arguments are moot.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 and 3-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/244,159. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the applicant (broad) are embraced by the copending application (narrow).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

With regard to claim 1 of application 11/244,159, the copending application teaches, stretching in the widthwise direction while shrinking in the longitudinal direction. The copending application further teaches the same ratios as the application being examined (SMD and STD). Additionally the copending application provides further

teachings such as having an Nz coefficient, thus making it narrower than the current applications claim (1). The copending application is narrower than the current application, thus claim 1 of the current application is embraced by the copending application.

***Claim Rejections - 35 USC § 102 / 35 USC § 103***

5. Claims 1, 3-6, and 7-8 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kuwamura (US 2004/0119178 A1).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claim 1 and 3-6 rejected under 35 U.S.C. 102(a) as being anticipated by Kuwamura (US 2004/0119178 A1).

Kuwamura teach a method of producing a polarizing plate by laminating a pair of curled protective sheets onto opposite sides of a polarizer (abstract). Kuwamura state that a birefringent film can be uniaxially stretched (i.e. stretched in the width direction) ([0052]). If the film material is stretched in the width direction, the film will necessarily be shrunk in the longitudinal direction. Kuwamura go on to teach that the stretching can be 1.1 to about 3.0 times (STD) ([0052]).

If one assumes that the original substrate has width (W) = 1 and length (L) = 2 (said assumption is reasonable based on the figures that show that L is about 2 times

W). Additionally, it is assumed that the stretching is uniform and that the thickness of the film does not change after stretching the area of the substrate *must* be the same before and after stretching.

From this, STD and SMD can be determined where

STD =  $W_2/W_1$  (where  $W_2$  = width after stretching &  $W_1$  = width before stretching)

SMD =  $L_2/L_1$  (where  $L_2$  = width after stretching &  $L_1$  = width before stretching)

Stretching at STD = 1.1

will yield  $W_1 = 1$  and  $W_2 = 1.1$

Now using the Area equation:  $A = W_2 * L_2$

Rearrangement yields:  $L_2 = A/W_2 = 2.0/1.1 = 1.818$

Therefore, SMD =  $L_2/L_1 = 1.818/2.0 = 0.91$

$$\text{Also, } \sqrt{\frac{1}{STD}} = \sqrt{\frac{1}{1.1}} = 0.95$$

Stretching at STD = 3.0

will yield  $W_1 = 1$  and  $W_2 = 3.0$

Now using the Area equation:  $A = W_2 * L_2$

Rearrangement yields:  $L_2 = A/W_2 = 2.0/3.0 = 0.67$

Therefore, SMD =  $0.67/2 = 0.333$

$$\text{Also, } \sqrt{\frac{1}{STD}} = \sqrt{\frac{1}{3}} = 0.577$$

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1 and 3-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuwamura (US 2004/0119178 A1).

Kuwamura teach a method of producing a polarizing plate by laminating a pair of curled protective sheets onto opposite sides of a polarizer (abstract). Kuwamura state that a birefringent film can be uniaxially stretched (i.e. stretched in the width direction) ([0052]). If the film material is stretched in the width direction, the film will necessarily be shrunk in the longitudinal direction. Kuwamura go on to teach that the stretching can be 1.1 to about 3.0 times (STD) ([0052]).

If one assumes that the original substrate has width (W) = 1 and length (L) = 2 (said assumption is reasonable based on the figures that show that L is about 2 times W). Additionally, it is assumed that the stretching is uniform and that the thickness of the film does not change after stretching the area of the substrate *must* be the same before and after stretching.

From this, STD and SMD can be determined where

STD =  $W_2/W_1$  (where  $W_2$  = width after stretching &  $W_1$  = width before stretching)

SMD =  $L_2/L_1$  (where  $L_2$  = width after stretching &  $L_1$  = width before stretching)

Stretching at STD = 1.1

will yield  $W_1 = 1$  and  $W_2 = 1.1$

Now using the Area equation:  $A = W_2 * L_2$

Rearrangement yields:  $L_2 = A/W_2 = 2.0/1.1 = 1.818$

Therefore,  $SMD = L_2/L_1 = 1.818/2.0 = 0.91$

$$\text{Also, } \sqrt{\frac{1}{STD}} = \sqrt{\frac{1}{1.1}} = 0.95$$

Stretching at STD = 3.0

will yield  $W_1 = 1$  and  $W_2 = 3.0$

Now using the Area equation:  $A = W_2 * L_2$

Rearrangement yields:  $L_2 = A/W_2 = 2.0/3.0 = 0.67$

Therefore,  $SMD = 0.67/2 = 0.333$

$$\text{Also, } \sqrt{\frac{1}{STD}} = \sqrt{\frac{1}{3}} = 0.577$$

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1 and 3-6, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwamura (US 2004/0119178 A1).



From the teaching of the applied reference and above assumptions, it's reasonably expected that the uni-stretching in the width direction of a birefringent film in the stretching ratio range of 1.1 to 3 anticipates the instant claim since the prior art range meets the claimed formula. If there is any difference, the difference must be minor and unobvious since the prior art range would be close to or overlap the claimed formula. The burden is shifted to Applicant who must show that the stretching process of the applied reference fall outside the claimed formula.

12. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwamura (US 2004/0119178 A1) as applied to claim 1 above, and further in view of Applicant's Admitted Prior Art (AAPA).

Kuwamura fails to teach the use of a base or that the birefringent film and the base are stretched at the same time. AAPA teaches that a polymer (birefringent) film is formed on a base directly and then stretched together with the base ([0005]). It would have been obvious to one having ordinary skill in the art at the time of the invention to attach the birefringent film of Kuwamura to a base and stretch them at the same time because this is an art recognized method of processing birefringent films as exemplified by the teaching of AAPA.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAEED M. HUDA whose telephone number is (571)270-5514. The examiner can normally be reached on 8:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KHANH NGUYEN/  
Primary Examiner, Art Unit 1791

/SAEED M. HUDA/  
Examiner, Art Unit 1791